UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/649,268	08/28/2000	Michael S. Chartier	042390.P219	6762

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EXAMINER
SCHNEIDER, JOSHUA D

ART UNIT	PAPER NUMBER
2182	

DATE MAILED: 03/16/2004

/12

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 February 2004*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
   application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)   4)☐ Interview Summary (PTO-413)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)   Paper No(s)/Mail Date. _____.
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)   5)☐ Notice of Informal Patent Application (PTO-152)
   Paper No(s)/Mail Date _____.   6)☐ Other: _____.

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments filed 7/25/2003 have been fully considered but they are not persuasive. With regards to the arguments that U.S. Patent 5,748,084 to Isikoff does not teach a first processor and a second processor, Applicant is directed to Figures 3 and 4. Isikoff teaches an activated modem processor that receives and stores data (Fig. 3, column 3, lines 62-65, and column 5, lines 54-49) while a first central processor of the host computer is deactivated (Fig. 4, column 9, lines 15-27). The processor of the modem (beacon) operates independently of the processor of the host computer.

2.   With regards to the arguments that any activity taught by Isikoff involving the data modem also involves the microprocessor (30), applicant again pointed to Figs. 3 and 4. It is shown in these figures that there are in fact two processors in the system, one of which can be inactive while the second, resident in the modem, remains active for the sending and receiving of communications. Microprocessor 30 in the beacon remains active, while the host processor of the computer in which the beacon resides is inactive.

3.   With regards to the argument that the user does not use the data stored by the beacon, the applicant has presented points to only parts of the reference that may seem to help the argument. In the previous argument, the applicant cited sections of the reference that make it quite clear that the data is for use by the user. It is unclear how the sending of voice calls, emails, and even control codes can be interpreted as for the use of anything but a user (page 7, paragraph 4).

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5.   Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is made clear that the data is stored for future use, but not how the data is to be used without the first processor.

6.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7.   Claims 1 and 3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regards to claims 1 and 3, the use of the terms processor and modem processor creates confusion, as the name of the first element is included in the name of the second element. Clarification of the term processor is therefore required.

8.   All further objections and rejections are made in view of the specification as best understood in light of the previous objections and rejections.

Claim Rejections - 35 USC § 102

9.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10.   Claims 8-9, 13-14, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by

U.S. Patent 5,748,084 to Isikoff. With regards to claim 8, Isikoff teaches an activated modem

processor which receives and stores data for future use by a user (Fig. 3, column 3, lines 62-65,

and column 5, lines 54-49) when a first processor of the host computer is deactivated (Fig. 4,

column 9, lines 15-27).

11.   With regards to claim 9, Isikoff teaches the beacon unit controls the power supply

(column 4, lines 15-20, column 2, lines 12-14, and column 9, lines 15-17).

12.   With regards to claims 13 and 14, Isikoff teaches the processor stores in memory user file

names and types which are to be transferred (column 6, lines 5-11).

Claim Rejections - 35 USC § 103

13.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

14.   Claims 1-7, 10-12, 15, 16, and 18-20 are rejected under 35 U.S.C. 103(a) as being

unpatentable over U.S. Patent 5,748,084 to Isikoff. With regards to claims 1, 18, and 19, the

Isikoff reference teaches a beacon unit (Fig. 3) comprising a modem adapted to receive

communication for future use by a user, a processor coupled to the modem (Fig. 4), and a

memory coupled to the modem when the processor is inactive (column 3, line 62, through

column 4, line 2, and column 9, lines 15-27). It is inherent that a user programs the processes of

the modem, as there is no other way for the modem to be functional in such a manner. While

Isikoff does not explicitly teach non-volatile memory, the beacon is battery backed and retains

power even when power is removed from the main computer and processor (Figs. 3 and 4). It

would have been obvious to one of ordinary skill in the art at the time of invention that the

beacon memory of Isikoff is battery backed and is therefore nonvolatile.

15.   With regards to claim 2, Isikoff teaches a hard drive that is coupled to the processor

(column 4, lines 15-20).

16.   With regards to claim 3, Isikoff teaches the beacon/modem processor (Fig. 3, element 30)

that operates independently of the main processor (column 9, lines 15-27).

17.   With regards to claim 4, Isikoff teaches that the beacon communication handling section

logs unimportant requests, when the main processor is inactive, to be handled at another time to

save power (column 9, lines 15-32).

18.   With regards to claims 5 and 6, Isikoff teaches the beacon transmitting messages from

memory when the main computer is powered down (column 6, lines 2-16, and column 9, lines

33-52).

19.   With regards to claim 7, the memory stores user profile information regarding what types

of files are to be transferred and stored in the memory (column 6, lines 2-16).

20.   With regards to claim 10, While Isikoff does not explicitly teach non-volatile memory;

the beacon is battery backed and retains power even when power is removed from the main

computer and processor (Figs. 3 and 4). It would have been obvious to one of ordinary skill in

the art at the time of invention that the beacon memory of Isikoff is at least battery backed and is

therefore nonvolatile.

21.   With regards to claim 11, Isikoff teaches that the beacon processor stores data into the

memory (column 9, lines 15-32). Flash memory is well known in the art and it would have been

obvious to one of ordinary skill in the art at the time of invention that the beacon memory could

be a flash memory array.

22.   With regards to column 12, Isikoff teaches the host computer being passed data to be

processed (column 5, lines 47-51). It would have been obvious to one of ordinary skill in the art

at the time of invention that the host processor would be involved in this access.

23.   With regards to claims 15 and 16, Isikoff teaches the beacon processor stores user profile

information in the memory regarding what types of files are to be transferred and stored in the

memory (column 6, lines 2-16). It would have been obvious to one of ordinary skill in the art at

the time of invention that either processor could have been used to store user profile identifying

information into the memory.

24.   With regards to claim 20, Isikoff teaches wireless communication with a modem (Figs. 1
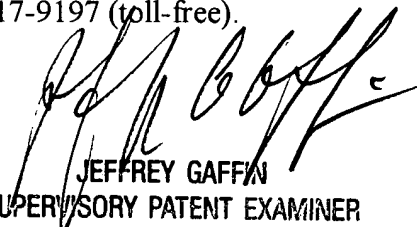
and 3).

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Joshua D Schneider whose telephone number is (703) 305-7991.

The examiner can normally be reached on M-F, 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jeffrey A Gaffin can be reached on (703) 308-3301. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JDS

JEFFREY GAFFIN

SUPERVISORY PATENT EXAMINER

TECHNOLOGY CENTER 2100